UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,321	12/23/2003	Peter Elms	86769-0026 US	5565

30398 7590 08/15/2007	EXAMINER	
ACCENTURE, LLP	PARTHASARATHY, PRAMILA	
C/O HOGAN & HARTSON, LLP (IPGROUP)		
555 13TH STREET NW, SUITE 600E	ART UNIT	PAPER NUMBER
WASHINGTON, DC 20004	2136	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/743,321	ELMS ET AL.
	Examiner	**Art Unit**	
	Pramila Parthasarathy	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 June 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-41</u> is/are pending in the application.

    4a) Of the above claim(s) <u>19-23; 31-41</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-18; 24-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/04; 1/06</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1.   Applicant's election without traverse of Claims 1 – 18 and 24 – 30, i.e., the Group

I claims, in the reply filed on June 19, 2007 is acknowledged. Pending claims are 1 – 18

and 24 – 30.

Priority

2.   Acknowledgment is made of applicant's claim for foreign priority under 35

U.S.C. 119(a)-(d).

Information Disclosure Statement

3.   Two initialed and dated copies of Applicant's IDS form 1449 are attached to the

Office action.

Double Patenting

        The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ
644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.   Claims 1 – 18 and 24 – 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 24 of U.S. copending application No. 11/176,681. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 18 and 24 – 30 correspond to the claims of the copending claims and copending claims encompass the scope of Claims 1 – 18 and 24 – 30 of the instant application.

The instant application generally claims a method for registering a user to vote with the user's local election office through a secure electronic registration and voting system, comprising the steps of logging into the secure electronic registration and voting system by the user. Copending application 11/176,681 claims similar limitations with "a computer for allowing a user to access an authentication system and a central hosting facility through a network wherein the authentication system performs identity proofing an assigns a roaming digital certificate to the user in response the user submitting an approved credential and registers the user to vote with the central hosting facility", which is equivalent to the instant application "signing the completed electronic application with a digital signature assigned to the user" and "..the identification and authentication process element further comprises: ... roaming digital certificate and managed public key infrastructure services".

This is a _provisional_ obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5.   Claims 1 – 18 and 24 – 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 23 of U.S. copending application No. 11/176,682. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 18 and 24 – 30 correspond to the claims of the copending claims and copending claims encompass the scope of Claims 1 – 18 and 24 – 30 of the instant application.

The instant application generally claims a method for registering a user to vote with the user's local election office through a secure electronic registration and voting system, comprising the steps of logging into the secure electronic registration and voting system by the user. Copending application 11/176,682 claims similar limitations with "a dynamic electronic voting auditing through an electronic registration and voting system, comprising the steps of: providing a computer to a test user; ... the remote server authenticating the associated test voting data with the test user identifier and storing the authenticated encrypted test voting data", which is equivalent to the instant application "signing the completed electronic application with a digital signature assigned to the user" and "..the ballot reconciliation and tabulation process element further comprises: ... voter identification and ballot separation services .. download encrypted ballot to local election office services".

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6.   Claims 1 – 18 and 24 – 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 30 of U.S. copending application No. 11/176,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 18 and 24 – 30 correspond to the claims of the copending claims and copending claims encompass the scope of Claims 1 – 18 and 24 – 30 of the instant application.

The instant application generally claims a method for registering a user to vote with the user's local election office through a secure electronic registration and voting system, comprising the steps of logging into the secure electronic registration and voting system by the user. Copending application 11/176,685 claims similar limitations with "a method for identifying and authenticating a user through a secure electronic registration and voting system comprising the steps of: providing a computer to a user; the computer signing a completed electronic application with a digital signature assigned to the user", which is equivalent to the instant application "signing the completed electronic application with a digital signature assigned to the user" and "..the identification and authentication process element further comprises: ... roaming digital certificate and managed public key infrastructure services".

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

7.   Figure 2b should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

of the claimed invention. Claim 9 recites "The secure electronic registration ... further

comprises: ... secure messaging services' ...". With respect to "secure messaging

services", the instant application does not describe what constitutes "secure messaging

services".

9.   Claims 18 and 24 – 30 are rejected under 35 U.S.C. 112, first paragraph, as

based on a disclosure which is not enabling. "roaming digital signature" critical or

essential to the practice of the invention, but not included in the claim(s) is not enabled

by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Applicant claims that the invention remedies the deficiencies inherent in existing

(current) voting solutions by "assigning roaming digital certificate" that is not tied to a

specific computer and therefore, the user is not required to use the same computer

each time he accesses the central hosting facility. However neither claim 18 nor Claims

24 – 30 recites, "roaming digital signature".

        The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

10.   Claims 3, 29 and 30 rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

        Claim 3 recites the limitation "the processing segment" in line 5. There is

insufficient antecedent basis for this limitation in the claim. Examiner suggests

amending with "the **application** processing segment".

Claim 29 recites the limitation "the step of reviewing the electronic application " in

line 1-2. There is insufficient antecedent basis for this limitation in the claim. Examiner

suggests amending with "The method of **Claim 28**, wherein the step of reviewing the

electronic application".

Claim 30 recites the limitation "the step of reviewing the electronic application" in

line 1-2. There is insufficient antecedent basis for this limitation in the claim. Examiner

suggests amending with "The method of **Claim 28**, wherein the step of reviewing the

electronic application".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 18 and 24 – 30 are rejected under 35 U.S.C. 102(b) as being

anticipated by Rodriguez et al. (U.S. Publication Number 2002/0138341).

12. As per Claim 1, Rodriguez teaches "a central hosting facility connected to the

network, the central hosting facility including a home page as an access point, an

application processing segment for providing election processing, and a storage

segment for temporary and persistent storage of data; and a computing device

connected to the network for accessing the central hosting facility" (summary and

paragraph [0025 – 0058]).

Rodriguez discloses a network system that includes a Transaction Repository

server site , a Transaction mediator server site (authenticates identities using

cryptographic information transmitted between the first computer and TR server; verifies

digital signatures and validates cryptographic identification of citizens (votes, users);

maintains electronic registration forms) connected over an electronic communications

network such as, for example, the Internet.

13.   As per Claims 2 – 17, 18 and 25 – 30, Rodriguez teaches "a central hosting

facility, including a system web server for housing a home page and web pages, a data

storage device for storing local election office data, and an application processing

segment providing the voting related subsystems and processes, the application

processing segment further including an identification and authentication subsystem

and associated services for identity proofing and assigning a roaming digital certificate

to users and local election officials by the user or local election official submitting an

approved credential or retrieving, completing, and submitting an identity proofing form, a

voter registration subsystem and associated processes for registering a user to vote by

completing an electronic application, digitally signing the application with the assigned

roaming digital certificate, and having the application submitted electronically, wherein a

local election official may review the application, approve or deny the application,

update the status of the application, and communicate the status of the application to

the user, a ballot creation subsystem and associated processes for creating a ballot

definition file by an official of the local election office, transforming the ballot definition

file to a standard format, validating the ballot by the local election official, and providing

the ballot for use by the user, a voting subsystem and associated processes for

providing secure voting by identifying and authenticating a user that logs in to vote and

request a ballot, retrieving the user's identification information and digital certificate,

generating a ballot from the user's local election office ballot definition file, digitally

signing the ballot, sending the ballot to the user, receiving from the user the completed

ballot digitally signed with the user's roaming digital certificate, time stamping the ballot,

encrypting the ballot with a user's symmetric key, and storing the encrypted ballot,

transmitting a ballot summary to the user for confirmation, receiving confirmation, time

stamping the ballot and encrypting the user's symmetric key with a local election office's

public key, and storing the encrypted symmetric key and associated encrypted ballot in

the local election office's electronic ballot box, a ballot tabulation and reconciliation

subsystem and associated processes for reconciling encrypted ballots, wherein ballot

tabulation includes providing a local election office with a token and a tabulation

computer and requiring one election official to login to the tabulation computer and a

second election official to login to the central hosting facility, separating voter

identification information from the encrypted ballots and transferring the encrypted

ballots to the tabulation computer, decrypting the ballots by decrypting the symmetric

key associated with each ballot with the local election office's public key and decrypting

each ballot with its associated symmetric key, and tabulating the decrypted ballots, and

a common services subsystem and associated processes; and a computer for

accessing the central hosting facility through the network" (summary and paragraph

[0025 – 0058]).

Rodriguez discloses a network system that includes a Transaction Repository

server site , a Transaction mediator server site (authenticates identities using

cryptographic information transmitted between the first computer and TR server; verifies

digital signatures and validates cryptographic identification of citizens (votes, users);

maintains electronic registration forms) connected over an electronic communications

network such as, for example, the Internet. The user transmits registration information

from the first computer to a database that resides on a TR server, the information can

include either the descriptive elements or electronic registration form. The registration

information and the form are digitally signed, the identification tag of the appropriate TR

server is attached to the information. The server verifies the digital signature of the

registration information and validity of the cryptographic identification (created and

issued by TR server). The TR server verifies and confirms the validity of the user to the

TM server and upon request by the registered voter (user), if the user is eligible to vote,

an electronic ballot (which can have a digital certificate) is transmitted to the user. The

user supplies the necessary information on the ballot and digitally signs (symmetric key)

the ballot before transmitting to the TM server. TM server can attach a date-time stamp

to the voted electronic ballot and sends it to the TR server where each electronic ballot

is processed and tallied.

14. As per Claim 24, Rodriguez teaches "logging into the secure electronic

registration and voting system by the user; authenticating the user as a valid user;

completing an electronic application by the user; signing the completed electronic

application with a digital signature assigned to the user; submitting the digitally signed

electronic application; storing the electronic application in a database on the secure

electronic registration and voting system assigned to the user's local election office; and

notifying the user's local election office of the receipt of the user's completed electronic

application" (summary and paragraph [0025 – 0058]).

Rodriguez discloses a network system that includes a Transaction Repository

server site , a Transaction mediator server site (authenticates identities using

cryptographic information transmitted between the first computer and TR server; verifies

digital signatures and validates cryptographic identification of citizens (votes, users);

maintains electronic registration forms) connected over an electronic communications

network such as, for example, the Internet. The user transmits registration information

from the first computer to a database that resides on a TR server, the information can

include either the descriptive elements or electronic registration form. The registration

information and the form are digitally signed, the identification tag of the appropriate TR

server is attached to the information. The server verifies the digital signature of the

registration information and validity of the cryptographic identification (created and

issued by TR server). The TR server verifies and confirms the validity of the user to the

TM server and upon request by the registered voter (user), if the user is eligible to vote,

an electronic ballot (which can have a digital certificate) is transmitted to the user. The

user supplies the necessary information on the ballot and digitally signs (symmetric key)

the ballot before transmitting to the TM server. TM server can attach a date-time stamp

to the voted electronic ballot and sends it to the TR server where each electronic ballot

is processed and tallied.

Conclusion

15.   Examiner's Note: Examiner has cited particular columns and line numbers in the

references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures

may apply as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

16.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be

evaluated by what they suggest to one versed in the art, rather than by their specific

disclosure. If applicants are aware of any better prior art than those are cited, they are

required to bring the prior art to the attention of the examiner.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Pramila Parthasarathy whose telephone number is 571-

272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts

to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

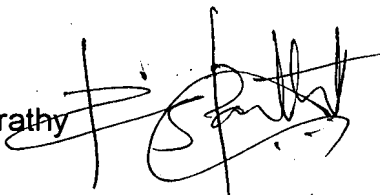Nasser Moazzami can be reached on 571-232-4195. Any inquiry of a general nature or

relating to the status of this application or proceeding should be directed to the

receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR only. For more

information about the PAIR system, contact the Electronic Business Center (EBC) at

866-217-9197 (toll-free).

Pramila Parthasarathy

August 11, 2007.